

**AMENDMENTS TO THE DRAWINGS**

Applicant is submitting herewith one (1) sheet of replacement drawings, which includes FIGS. 1-3. FIG. 1 has been amended to show the guide insertion tube 8.

Attachment: Replacement Sheet

**REMARKS**

Claims 1-15 are all the claims pending in the application. Claims 1, 10 and 15 are independent claims.

**Drawing Objection**

The Examiner has objected to the drawing figures. Specifically, the Examiner has indicated that the “guide insertion tube” of dependent claims 13 and 14 should be either shown in the drawings or eliminated from the claims. In response, Applicant respectfully amends FIG. 1 to show the guide insertion tube 8. Applicant has also amended the specification so that it refers to reference numeral 8.

**Claim Rejections under 35 U.S.C. § 102**

Claims 1, 4, 8, and 9 are rejected under 35 U.S.C. § 102(b) as being anticipated by D'Amico (US 5,429,613). Claims 1 and 6 are rejected under 35 U.S.C. § 102(b) as being anticipated by Pike (5,954,698). Claims 1, 2, and 14 are rejected under 35 U.S.C. § 102(b) as being anticipated by Kulik (US 1,551,159). Claims 1 and 4 are rejected under 35 U.S.C. § 102(b) as being anticipated by Lawrence (US 6,346,115). Claims 1 and 6 are rejected under 35 U.S.C. § 102(b) as being anticipated by Wilkens et al. (WO 98/23321). Claims 1 and 3 are rejected under 35 U.S.C. § 102(e) as being anticipated by Nissan et al. (US 2004-0093084).

With respect to independent claim 1, Applicant has amended the claim to recite that the needle is an acupuncture needle including a means for causing a vibration including at least one flat portion. Applicant respectfully requests that the Examiner withdraw these rejections at least because none of these applied references discloses such an acupuncture needle.

For example, D'Amico, Kulik, and Nissan disclose needles that deliver fluid; Wilkens disclose a needle for draining fluid; Pike discloses a catheter insertion apparatus; and Lawrence discloses a sliding knife and needle assembly used for endoscopic or arthroscopic surgery.

Moreover, none of these references discloses the claimed function of causing a vibration in the shaft when the handle is rotated. In fact, none of these references discloses rotating the needle. That is, the handle of *each* these needles is designed to be held steady by a practitioner. For example, the handle of Lawrence's sliding knife and needle assembly is designed to be held in the direction in which the knife blade faces down.

In view of these amendments, applicant respectfully requests the Examiner to withdraw these rejections of claim 1.

Applicant also respectfully requests the Examiner to withdraw these rejections of dependent claims 1-4, 6, 8, 9, and 14.

**Claim Rejections Under 35 U.S.C. § 103**

Claims 1, 3-9, 14, and 15 are rejected under 35 U.S.C. § 103(a) as being obvious over Chang (US 4,950,279). Claims 2 and 10-13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Chang in view of Mink (US 5,896,620).

**Claim 1**

As discussed above, Applicant has amended independent claim 1 to recite that the needle is an acupuncture needle including a means for causing a vibration including at least one flat portion. Applicant respectfully requests that the Examiner withdraw the §103 rejections at least because Chang would not reasonably teach or suggest the claimed acupuncture needle.

Chang discloses an acupuncture needle including a handle 14 with a “pineapple” pattern of surface indentations 24. The Examiner alleges that it would be an obvious design choice to modify the handle 14 to use the various handle shapes of the prior art references applied in the §102 rejections in order to provide the user with improve dexterity or frictional surfaces for applying torque.<sup>1</sup>

However, the Examiner has not provided any *evidence* why the various handle designs discussed above would improve the dexterity or frictional forces of an acupuncture needle. That is, Chang specifically discloses that the ‘pineapple pattern’ provides a “greater tactile sensation which enables the practitioner to rotate the needle and/or further penetrate the body member with more ease and precision.”<sup>2</sup>

In contrast, there is no suggestion that the various handle shapes of the prior art references applied in the §102 rejections, which are designed to provide increased ability to use those needles (for example, for the insertion/draining of fluid), would provide improved dexterity or torque when rotating Chang’s acupuncture needle.

Moreover, it is likely that the large flat pattern used for gripping those other needles would inhibit rotation. That is, the handle of an acupuncture needle is typically rotated by rotating the handle with one’s fingers and thumb.<sup>3</sup> In contrast, there is no disclosure in the applied references that the handles are designed to be rotated in this way. In fact, it seems that the handles of the applied references are not designed to be rotated.

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<sup>1</sup> See Office Action at page 4.

<sup>2</sup> See Chang at 3:20-24.

<sup>3</sup> See original specification at page 2, last paragraph.

Finally, the use of a *design choice* rejection is not appropriate where the applicant has demonstrated the criticality of the claimed feature.<sup>4</sup> In this case, the original specification discloses that the claimed shape of the handle provides a vibration that gives an enhanced effect.<sup>5</sup>

Therefore, Applicant respectfully requests the Examiner to withdraw the rejection of independent claim 1.

Applicant also respectfully request the Examiner to withdraw this rejection of dependent claims 3-9, 14 at least because of their dependency from claim 1.

With respect to claim 2, Applicant also respectfully request the Examiner to withdraw the rejection at least because of their dependency from claim 1 and because, as discussed below with respect to independent claim 10, Mink does not cure the deficiencies in Chang.

Claim 10

With respect to independent claim 10, Applicant has also amended the claim to recite that the needle is an acupuncture needle. Applicant respectfully requests that the Examiner withdraw these rejections at least because none of these applied references discloses the claimed acupuncture needle including a said handle including a first cross-sectional shape that includes an circular portion and a chord portion.

The Examiner acknowledges that Chang does not disclose a needle in which the handle includes a first cross-sectional shape that includes a circular portion and a chord portion. Therefore, the Examiner looks to the brush handle of Mink in an attempt to make up for this

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<sup>4</sup> See MPEP 2144.04.

<sup>5</sup> See original specification at page 1, Summary of the Invention section.

deficiency. The brush handle 3 of Mink includes a rounded egg-like or tear drop section 7 and a flat thumb rest portion 9.<sup>6</sup>

First, Applicant respectfully submits that Mink is not analogous art and therefore cannot support this rejection under 35 U.S.C. § 103.<sup>7</sup> That is, the brush art is neither in the field of applicant's endeavor or reasonably pertinent to the problem with which the invention is concerned. Thus, one of ordinary skill in the acupuncture needle art would not have looked to the brush art in an attempt to modify the design of an acupuncture needle.<sup>8</sup>

Next, the rejection is deficient at least because the Examiner has not provided any evidence of a suggestion, or reason, why one of ordinary skill would want to provide a thumb rest in the handle of an acupuncture needle.<sup>9</sup> As discussed above, the handle of an acupuncture needle is typically rotated between one's fingers and thumb.<sup>10</sup> Assuming *arguendo* that the handle of a *theoretical* acupuncture needle were modified to include a thumb rest, continuously resting the thumb on a same portion during rotation would provide an awkward rotation.

Thus, Applicant respectfully requests the Examiner to withdraw the rejection of independent claim 10. Applicant also respectfully requests the Examiner to withdraw the rejection of dependent claims 11-13 at least because of their dependency from claim 10.

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<sup>6</sup> See Mink at, for example, 3:49-59.

<sup>7</sup> See MPEP

<sup>8</sup> See MPEP 2141.01(a).

<sup>9</sup> See MPEP 2143.01.

<sup>10</sup> See original specification at page 2, last paragraph.

Claim 15

With respect to independent method claim 15, Applicant has also amended the claim to recite that the needle is an acupuncture needle and that the handle includes at least one flat portion.

Applicant respectfully requests the Examiner to withdraw this rejection of independent claim 15 at least because Chang does not reasonably teach or suggest the claimed method including rotating the handle, which includes at least one flat portion, of an acupuncture needle so as to cause the shaft to vibrate, as is discussed above with respect to independent claim 1.

New Claims

Finally, Applicant has added new dependent claims 16-18, which further recite that the shaft does not have a hollow lumen, an inherent feature of an acupuncture needle. Applicant respectfully submits that these claims are patentable at least because of their dependency from one of claims 1, 10, or 15.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.111  
U.S. Application No. 10/791,378

A8714

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

/John M. Bird/

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Date: March 12, 2007

Attorney Docket No.: A8714